

REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on August 13, 2001, and the references cited therewith.

Claims 1, 2, 8, 11, 26, and 30-33 are amended and claim 34 is added; as a result, claims 1-34 are now pending in this application.

§112 Rejection of the Claims

Claims 3, 18, 24, 32, and 33 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended claims 32 and 33 to clarify the reference to "the gap."

Applicant traverses the rejection of claims 3, 18, and 24. Applicant notes that Applicant is his own lexicographer. In the application, Applicant describes "gap" on page 4, lines 20-28 as follows:

"In this embodiment, gap 122 is a section in the second layer where there is complete separation between the two sections 121a and 121b of the second layer. However, in some embodiments, gap 122 may only partially separate the two sections. For instance, gap 122 may only run a partial distance along layer 120 so that sections 121a and 121b are partially connected and partially disconnected. In other embodiments, gap 122 may be a series of perforations, notches, or other partial or complete discontinuity in second layer 120. Thus, the term gap is to be taken as a portion of second layer 120 where there is some discontinuity in the layer."

Applicant respectfully requests submits that the claims are consistent with this description and respectfully requests reconsideration and allowance of claims 3, 18, 24, 32, and 33.

§102 Rejection of the Claims

Claims 1-5, 11, and 15-19 were rejected under 35 USC § 102(b) as being anticipated by Fabel (U.S. Patent No 5,836,622).

Fabel discusses a post card form which is designed to be printed on one side of the form and then folded in various configurations to create double sided postcards, mailers, etc. (See Abstract of Fabel). However, Fabel does not discuss subject matter to allow a label to be easily

folded or aligned upon the edge of a folder or other stock member as in the present labeling system.

Claims 1-5

Applicant has amended claim 1 to better describe the subject matter recited in the claim. Applicant submits that Fabel does not anticipate amended claim 1 since the reference does not include each limitation of the claim. For instance, Fabel does not discuss a label which includes “a second layer permanently attached to the second surface of the first layer,” the second layer comprising a first section and a second section having a gap therebetween, said gap defining a fold-line section in the first layer, wherein when a folding pressure is applied to the label, “the label folds along the fold-line section such that the first section of the second layer is attachable to a first side of the stock member and the second section of the second layer is attachable to a second side of the stock member.”

In contrast, Fabel discusses a post card form in which the first section 26 of back sheet 14 is not “permanently attached” to layer 12 but is peeled off of layer 12 and thus is not “attachable to a first side of the stock member,” as recited in claim 1. (See Fabel column 4, lines 42-46). This distinction allows the label of the present system to be applied over the edge of the stock member in a predictable manner. Fabel does not include any discussion of having a label mountable to over the edge of a stock member.

Dependent claims 2-5 include all the limitations of parent claim 1 and are therefore allowable over Fabel as discussed above for claim 1. Reconsideration and allowance of claims 1-5 is respectfully requested.

Claim 11 and 15-19

Applicant has amended claim 11 to better describe the subject matter recited in the claim. Applicant submits that Fabel does not anticipate amended claim 11 since the reference does not include each limitation of the claim. For instance, Fabel does not discuss a label which includes a second layer having at least two sections at least partially separated by a gap, “the gap being discernible through the first layer,” the second layer “having an adhesive on an outer surface for applying the label to a stock member having at least two surfaces,” wherein “the label folds

along the discernible gap” such that the at least two sections are mountable on different surfaces of the stock member when the label is applied over an edge of the stock member. Among other advantages, the discernible gap allows the label to be visually aligned with the edge of a stock member when a user is applying the label while looking at the first layer. Also, the discernible gap of the claimed label allows the user to predict where the label will fold and this allows the user to align the label without having to look at the back of the label each time to see where it will fold.

Dependent claims 15-19 include all the limitations of parent claim 11 and are therefore allowable over Fabel as discussed above for claim 11. Reconsideration and allowance of claims 11 and 15-19 is respectfully requested.

§103 Rejection of the Claims

Claims 6-10, 12-14, and 20-29 were rejected under 35 USC § 103(a) as being unpatentable over Fabel (U.S. Patent No. 5,836,622).

Claims 6-10

Claims 6-10 include all the limitations of amended parent claim 1 and Applicant believes the claims are therefore patentable over Fabel under 35 USC § 103 since Fabel does not include any suggestion or motivation to include the subject matter of parent claim 1.

Moreover, regarding claim 9, Applicant traverses the Office Action’s assertion that it is a matter of design choice to modify Fabel to have “the second layer comprises a material which is darker than the material of the first layer.” A rejection under 35 USC 103 requires a motivation or suggestion to provide the missing subject matter. Here Fabel impliedly teaches away from such subject matter since half of Fabel’s second layer is thrown away, there is simply no reason to provide it as a darker material. There must be some motivation to support a 35 USC 103 rejection. Absent a motivating reference, Applicant submits the Office Action is taking Official Notice of this subject matter and Applicant respectfully traverses and requests the Examiner to cite references in support of this position, pursuant to M.P.E.P. § 2144.03.

Likewise, regarding claim 10, Applicant traverses the Office Action’s assertion that a discernible gap is a mere design choice. Again, a rejection under 35 USC 103 requires a motivation or suggestion to provide the missing subject matter. The claimed label allows a user

to visually identify where the gap in the label is. This allows the user to visually align the label knowing where the fold line will be. This advantage is not discussed or suggested by the Fabel reference, accordingly there is no motivation to modify Fabel as asserted by the Office Action. Again, absent a motivating reference, Applicant submits the Office Action is taking Official Notice of this subject matter and Applicant respectfully traverses and requests the Examiner to cite references in support of this position, pursuant to M.P.E.P. § 2144.03.

Reconsideration and allowance of claims 6-10 is respectfully requested.

Claims 12-14 and 20-21

Claims 12-14 and 20-21 include all the limitations of amended parent claim 11 and Applicant believes the claims are therefore patentable over Fabel under 35 USC § 103 since Fabel does not include any suggestion or motivation to include the subject matter of parent claim 11.

Moreover, Applicant again traverses the assertion that the subject matter of claims 12-14 is a mere design choice. The discussion above regarding claim 9 is incorporated herein by reference. Reconsideration and allowance is respectfully requested.

Claims 22-25

Applicant traverses the rejection of claim 22. Applicant submits that claim 22 is not obvious in light of Fabel since the reference does not discuss or suggest each limitation of the claim. For instance, Fabel does not discuss a label which includes a first layer and a second layer, "the second layer comprising a darker material than the first layer, wherein each gap is discernible through the first layer and indicates the fold-line section of the first layer," Again, Applicant traverses the assertion that it would be obvious to modify the label of Fabel to provide a discernible gap as a matter of design choice. Applicant submits that Fabel does not include any suggestion or motivation for such subject matter. Fabel is concerned with folding forms into post cards, etc. Fabel is not concerned with the problem of aligning a label with the edge of a folder, as in the present system. The discernible gap of claim 22 allows a user to predict where a label will fold while the user is looking at the first layer of the label. This allows the user to align the label and then apply it quickly without having to guess where the label folds.

This advantage is not discussed or suggested by the Fabel reference, accordingly there is no motivation to modify Fabel as asserted by the Office Action. Again, absent a motivating reference, Applicant submits the Office Action is taking Official Notice of this subject matter and Applicant respectfully traverses and requests the Examiner to cite references in support of this position, pursuant to M.P.E.P. § 2144.03.

Claims 23-25 include all the limitations of parent claim 22 and are therefore allowable as discussed above for claim 22. Reconsideration and allowance is respectfully requested.

Claims 26-29

Applicant has amended claim 26 to better describe the subject matter recited in the claim. Applicant submits that claim 26 is not obvious in light of Fabel since the reference does not discuss or suggest each limitation of the claim. For instance, Fabel does not discuss a label which includes "a second layer permanently attached to the first layer" and removably attached to the backing member, the second layer comprising at least two sections having a gap therebetween, the first layer has a foldable section located along the gap of the second layer, wherein, when a folding pressure is applied to the label, the label folds along the foldable section such that "one section of the second layer is attachable to a first side of the stock member and a second section of the second layer is attachable to a second side of the stock member."

As discussed above for claim 1, this distinction allows the label of the present system to be applied on the edge of the stock member and aligned with the gap of the label. Fabel does not include any discussion of having a label mountable to over the edge of a stock member.

Claims 27-29 include all the limitations of parent claim 26 and are therefore allowable as discussed above for claim 26. Reconsideration and allowance is respectfully requested.

Claims 30-33 were rejected under 35 USC § 103(a) as being unpatentable over Fabel (U.S. Patent No. 5,836,622) in view of Cunningham (2,893,144).

Claims 30-31

Applicant has amended claim 30 to better describe the subject matter recited in the claim. Applicant submits that claim 30 is allowable over the references since, even if combined, the

combination does not include or suggest each limitation of the claim. For instance, Applicant cannot find in the combination a method including “aligning the label such that a discernible gap of the label is aligned with an edge of the stock member,” applying a first portion of the label to a first side of the edge of the stock member, folding the label along the discernible gap which is defined by a weakened fold-line running along a surface of the label, the weakened fold-line located between the first portion of the label and a second portion of the label, and applying the second portion of the label to a second side of the edge of the stock member.

Claim 31 includes all the limitations of parent claim 30 and is therefore allowable as discussed above for claim 30. Reconsideration and allowance is respectfully requested.

Claims 32-33

Applicant has amended claim 32 to better describe the subject matter recited in the claim. Applicant submits that claim 32 is allowable over the references since, even if combined, the combination does not include or suggest each limitation of the claim. For instance, Applicant cannot find in the combination a method including providing a label having a first layer having a top surface adapted to being printed on and a bottom surface, the label also having a second layer attached to the bottom surface of the first layer, the second layer comprising two or more sections, wherein between each of the two or more sections is a gap, “the gap defining a visually discernible fold-line section in the first layer,” the first layer folds along the fold-line section when a folding force is applied to the label, applying a first portion of the label to a first side of the edge of the stock member, folding the label along the fold-line section, and applying a second portion of the label to a second side of the edge of the stock member.

Claim 33 includes all the limitations of parent claim 32 and is therefore allowable as discussed above for claim 32. Reconsideration and allowance is respectfully requested.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-359-3267) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

STEVEN MACWILLIAMS

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

P.O. Box 2938

Minneapolis, MN 55402

(612) 359-3267

Date

11/13/01

By

Peter C. Maki

Peter C. Maki

Reg. No. 42,832

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 13th day of November, 2001.

Name

Sarah L. Reinhard

Signature

Sarah L. Reinhard